

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Jeyhan Karaoguz

Examiner: Melvin H. Pollack

Application No. 10/675,443

Art Unit: 2445

Filed: September 30, 2003

Conf. No. 5634

For: SERVER ARCHITECTURE SUPPORTING A PERSONAL MEDIA EXCHANGE
NETWORK

Electronically Filed on June 21, 2010

APPEAL BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Appellant requests that the Board of Patent Appeals and Interferences reverse the final rejection of claims 1-30 of the present application. This Appeal Brief is timely because it is being filed within one month of the May 21, 2010 mailing date of the Notice of Panel Decision from Pre-Appeal Brief Review.

**REAL PARTY IN INTEREST
(37 C.F.R. § 41.37(C)(1)(I))**

The real party in interest is Broadcom Corporation, a corporation organized under the laws of the state of California, having a place of business at 5300 California Avenue, Irvine, California 92617, which has acquired the entire right, title and interest in and to the invention, the application, and any and all patents to be obtained therefor, as set forth in the Assignment recorded at Reel 014253, Frame 0137, in the PTO Assignment Search room.

**RELATED APPEALS AND INTERFERENCES
(37 C.F.R. § 41.37(C)(1)(II))**

The Appellant is unaware of any related appeals or interferences.

**STATUS OF THE CLAIMS
(37 C.F.R. § 41.37(C)(1)(III))**

The present application includes pending claims 1-30 all of which have been rejected. Appellant identifies claims 1-30 as the claims that are being appealed. The text of the pending claims is provided in the Claims Appendix.

**STATUS OF AMENDMENTS
(37 C.F.R. § 41.37(C)(1)(IV))**

Following issuance of the Final Office Action on November 25, 2009, the Appellant filed a Reply and Amendment Under 37 C.F.R. 1.116 on January 25, 2010 and a Pre-Appeal Brief Request for Review on February 25, 2010. No claims were amended by either of these submissions and no claim amendments are presently outstanding.

**SUMMARY OF CLAIMED SUBJECT MATTER
(37 C.F.R. § 41.37(C)(1)(V))**

Independent claim 1 recites the following:

1. A method for setting up devices for communication, the method comprising:

in a communication network comprising a headend,¹ wherein said headend enables access to said communication network for at least a first device,

assigning,² by said headend, an address to said first device coupled to said communication network, wherein said address is associated with said first device in said communication network at a time of said assigning;

transferring,³ by said headend, said assigned address to said first device; and

in response to said headend receiving an identifier of said first device from said first device, communicating, by said headend, one or both of said transferred assigned address and/or said identifier of said first device to at least one communication server coupled to said communication network.⁴

¹ See, e.g., Application, Fig. 1A, refs. 109 and 110; see also, id., Fig. 1B, ref. 120; see also, id., Fig. 1C, ref. 130; see also, id., p. 11, ¶ 36, line 1 to ¶ 37, line 7; see also, id., p. 13, ¶ 42, line 1 to p. 17, ¶ 53, line 6.

² See, e.g., id., Abstract, lines 2-5; see also, id., p. 4, ¶ 10, lines 2-5; see also, id., p. 5, ¶ 13, lines 1-3; see also, id., p. 20, ¶ 62, lines 6-7; see also, id., Fig. 2, step 203.

³ See, e.g., id., Abstract, lines 4-5; see also, id., p. 4, ¶ 10, lines 2-5; see also, id., p. 5, ¶ 13, lines 3-4; see also, id., p. 20, ¶ 62, lines 6-7; see also, id., Fig. 2, step 203.

⁴ See, e.g., id., Abstract, lines 5-8; see also, id., p. 4, ¶ 10, lines 5-9; see also, id., p. 5, ¶ 13, lines 4-8; see also, id., p. 20, ¶ 62, lines 7-8; see also, id., Fig. 2, step 204.

Independent claim 11 recites the following:

11. A machine-readable storage⁵ having stored thereon, a computer program having at least one code section for setting up devices for communication, the at least one code section being executable by a machine for causing the machine to perform steps comprising:

in a communication network comprising a headend,⁶ wherein said headend enables access to said communication network for at least a first device,

assigning,⁷ by said headend, an address to said first device coupled to said communication network, wherein said address is associated with said first device in said communication network at a time of said assigning;

transferring,⁸ by said headend, said assigned address to said first device; and

in response to said headend receiving an identifier of said first device from said first device, communicating, by said headend, one or both of said transferred assigned address and/or said identifier of said first device to at least one communication server coupled to said communication network.⁹

Independent claim 21 recites the following:

21. A system for setting up devices for communication, the system comprising:

⁵ See, e.g., *id.*, p. 5, ¶ 12, lines 1-6.

⁶ See, e.g., *id.*, Fig. 1A, refs. 109 and 110; see also, *id.*, Fig. 1B, ref. 120; see also, *id.*, Fig. 1C, ref. 130; see also, *id.*, p. 11, ¶ 36, line 1 to ¶ 37, line 7; see also, *id.*, p. 13, ¶ 42, line 1 to p. 17, ¶ 53, line 6.

⁷ See, e.g., *id.*, Abstract, lines 2-5; see also, *id.*, p. 4, ¶ 10, lines 2-5; see also, *id.*, p. 5, ¶ 13, lines 1-3; see also, *id.*, p. 20, ¶ 62, lines 6-7; see also, *id.*, Fig. 2, step 203.

⁸ See, e.g., *id.*, Abstract, lines 4-5; see also, *id.*, p. 4, ¶ 10, lines 2-5; see also, *id.*, p. 5, ¶ 13, lines 3-4; see also, *id.*, p. 20, ¶ 62, lines 6-7; see also, *id.*, Fig. 2, step 204.

⁹ See, e.g., *id.*, Abstract, lines 4-8; see also, *id.*, p. 4, ¶ 10, lines 5-9; see also, *id.*, p. 5, ¶ 13, lines 3-4; see also, *id.*, p. 20, ¶ 62, lines 6-7; see also, *id.*, Fig. 2, step 203.

one or more circuits¹⁰ for use in a headend¹¹ communicatively coupled to a communication network, said one or more circuits operable to:

assign¹² an address to a first device coupled to the communication network, wherein said address is associated with said first device in said communication network at a time of said assigning;

transfer¹³ said assigned address to said first device; and

in response to receiving an identifier of said first device from said first device, communicate one or both of said transferred assigned address and/or said identifier of said first device to at least one communication server coupled to the said communication network.¹⁴

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL
(37 C.F.R. § 41.37(C)(1)(VI))

Claims 1-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,272,129 (Dynarski) in view of U.S. Patent 6,934,754 (West).

ARGUMENT
(37 C.F.R. § 41.37(C)(1)(VII))

The MPEP states the following regarding the requirements for establishing a *prima facie* case of obviousness:

¹⁰ See, e.g., *id.*, Fig. 1C, refs. 131-137; see also, *id.*, p. 13, ¶ 42, line 1 to p. 17, ¶ 53, line 6.

¹¹ See, e.g., *id.*, Fig. 1A, refs. 109 and 110; see also, *id.*, Fig. 1B, ref. 120; see also, *id.*, Fig. 1C, ref. 130; see also, *id.*, p. 11, ¶ 36, line 1 to ¶ 37, line 7; see also, *id.*, p. 13, ¶ 42, line 1 to p. 17, ¶ 53, line 6.

¹² See, e.g., *id.*, Abstract, lines 2-5; see also, *id.*, p. 4, ¶ 10, lines 2-5; see also, *id.*, p. 5, ¶ 13, lines 1-3; see also, *id.*, p. 20, ¶ 62, lines 6-7; see also, *id.*, Fig. 2, step 203.

¹³ See, e.g., *id.*, Abstract, lines 4-5; see also, *id.*, p. 4, ¶ 10, lines 2-5; see also, *id.*, p. 5, ¶ 13, lines 3-4; see also, *id.*, p. 20, ¶ 62, lines 6-7; see also, *id.*, Fig. 2, step 203.

¹⁴ See, e.g., *id.*, Abstract, lines 5-8; see also, *id.*, p. 4, ¶ 10, lines 5-9; see also, *id.*, p. 5, ¶ 13, lines 4-8; see also, *id.*, p. 20, ¶ 62, lines 7-8; see also, *id.*, Fig. 2, step 204.

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

See MPEP at § 2142, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006), and *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval). "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art." See *id.*, § 2143.01. Furthermore, in order to render the claims obvious, the asserted prior art combination must **teach or suggest each and every claim feature**. See *In re Royka*, 490 F.2d 981 (CCPA 1974) (to establish *prima facie* obviousness of a claimed invention, all the claim features must be taught or suggested by the prior art)¹⁵; see also *In re Wada and Murphy*, Appeal 2007-3733, citing *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (A proper obviousness determination requires that an Examiner make "a searching comparison of the claimed invention – **including all its limitations** – with the teaching of the prior art.")

If a *prima facie* case of obviousness is not established, Applicants have no obligation to submit evidence of nonobviousness:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

¹⁵ Emphasis added except where noted otherwise.

See MPEP at § 2142.

With these principles in mind, the Applicants now turn to the claim rejections in particular.

I. CLAIMS 1-30 ARE PATENTABLE OVER THE PROPOSED COMBINATION OF DYNARSKI AND WEST

A. Independent Claims 1

1. The Examiner Has Not Established That It Would Be Obvious to Combine Dynarski and West

In order to support an assertion of obviousness, the Examiner is required to provide "some articulated reasoning with some rationale underpinning to support the legal conclusion of obviousness." See *KSR* 127 S. Ct. at 1741 quoting *In re Kahn*, 441 F.2d at 988 (CA Fed. 2006). Put another way, the Examiner should "identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *Id.* The Examiner should make "explicit" this rationale of "the apparent reason to combine the known elements in the fashion claimed," including a detailed explanation of "the effects of demands known to the design community or present in the marketplace" and "the background knowledge possessed by a person having ordinary skill in the art." *Id.*

In the present instance, the Examiner admits that "Dynarski does not disclose that said address is associated with said first device in said communication network at a time of said assigning, nor transferring, by said headend, said assigned address to said first device." (See Final Office Action, p. 4.) In an attempt to make up for this deficiency, the Examiner turns to West. However, in proposing to combine Dynarski and West, the Examiner failed to provide any "articulated reasoning with some rationale

underpinning to support the legal conclusion of obviousness" in the detailed manner described in *KSR*.

The Examiner attempts to justify this combination as follows:

At the time the invention was made, one of ordinary skill in the art would have added West to Dynarski in order to improve address management (col. 2, lines 5-55.)

(Final Office Action, p. 4.) This single, conclusory sentence is the entire extent of the Examiner's justification for alleging that it would be obvious to combine Dynarski and West. This conclusory allegation does not provide "articulated reasoning with some rationale underpinning to support the legal conclusion of obviousness" in the detailed manner described in *KSR*. As such, the Examiner has not established a *prima facie* case of obviousness and the Board should withdraw the rejection of claim 1.

2. The Proposed Combination of Dynarski and West Fails to Disclose or Suggest The Assigning Limitation of the Claims

However, even if the references are combined in the manner proposed by the Examiner, the claims are still patentable because the resulting combination fails to teach or suggest all of the elements of the claims. In this regard, independent claims 1 is patentable because the proposed combination of Dynarski and West fails to disclose or suggest at least the limitation of "assigning, by said headend, an address to said first device coupled to said communication network," as recited by Appellant's claim 1.

The Examiner alleges the following regarding claim 1:

Dynarski teaches a method and system (abstract) for setting up devices for communication (col. 1, line 1 - col. 3, lines 35), the method comprising:

- a. in a communication network (col. 4, lines 34-45) comprising a headend, wherein said headend enables access to said communication network for at least a first device (Fig. 1, #22, home agent),
- b. assigning, by said headend, an address to said first device coupled to said communication network (Fig. 1, #14), wherein said address is associated with said first device in said communication network at a time of said assigning (col. 5, lines 3-62); and
- c. in response to said headend receiving an identifier of said first device from said first device, communicating, by said headend, one or both of said transferred assigned address and/or said identifier of said first device to at least one communication server coupled to said communication network (col. 6, line 55 – col. 8, line 50).

(See Final Office Action, p. 3.) Thus, the Examiner apparently cites reference numeral 14 of Dynarski as a first device and “home agent #22” as a “headend.” (See *id.*, p. 3.) However, as explained below, the “home agent #22” of Dynarski does not assign an address to any of reference numerals 10, 14, 16 or 24 of Dynarski.

In connection with the assigning step, the Office Action cites to column 5, lines 3-62 of Dynarski, which reads as follows:

In the illustrative embodiment of FIG. 1A, the backbone network 12 comprises an IP local area network (such as an Ethernet network) which is coupled by IP router 18 to a wide area IP network 20 such as the Internet. When an IP packet is generated by the PC 10 destined for the laptop computer 14, the IP protocol requires a destination address field in the packet corresponding to the device 14. This address field will result in the call being forwarded over the IP network 20 to a home agent 22 for the device 14. The home agent 22 comprises a gateway/router, which may be a router on the IP network 20, which acts as mechanism for coordinating the receipt and transmission of communication sessions for the device 14 from multiple remote terminals, such as terminals 10 or 24. The home agent 22 also performs these functions for a plurality of mobile wireless communications devices,

such as laptop computers 14 and 16. The problem arises in how to route the IP packet from the terminal 10 (or 24) to the destination device, particularly where the home agent does not have any information as to where the device 14 is located. For example, the home agent 22 may not have a mobility binding record or other data from which an IP address is assigned to the device 14 which can be used to route the IP packet to the laptop 14. This situation may occur if the device has not been active in recent past, has moved into or out of the area, etc.

In a preferred embodiment, the home agent 22 comprises a router that is coupled to local area network (LAN) 26 on which resides an authentication server 28, one or more Interworking Units 30 (network access servers coupling the wireless network to the local area network and IP network), and a Signaling System 7 network agent 34 coupling the local area network 26 to a Signaling System 7 network 36. The functionality of the home agent could also be incorporated into other types of devices, and even a general purpose computer on the LAN 26, and the particular manner in which the home agent is embodied is not particularly important. Further details on the functionality of the home agent can be found in the Request for Comments (RFC) 2002 document, which is incorporated by reference herein, a publicly available document familiar to persons skilled in this art.

The authentication server 28, in a preferred embodiment, comprises a RADIUS server (a known device) providing accounting, authorization and authentication functions for a plurality of mobile users 14 and 16. Among other things, the authentication server 28 maintains a table in memory that maps a destination IP address found in the IP packet from the remote terminal 10 or 24 destined for the wireless device 14 with information uniquely identifying the device 14 that is being "called" by the remote terminal, such as the IMSI/ESN number assigned to the wireless device 14. In a preferred embodiment, the authentication server 28 determines from the IP address or IMSI or ESN number a particular network to use to locate the device, such as the local area network 26 or the Signaling System 7 network 36. The authentication server 28 returns a vendor-specific attribute which informs the home agent 22 whether to use the LAN 26 or the SS7 network to find the mobile device 14.

(Dynarski, 5:3-62.) Nothing in this passage, nor any other portion of Dynarski discloses or suggests that the home agent 22 assigns an address to any of reference numerals 10, 14, 16 or 24 of Dynarski. To the contrary, Dynarski discloses that the home agent **receives** an IP packet, which includes an address. In particular, Dynarski states the following:

The method comprises the steps of **receiving** an Internet Protocol (IP) packet **from a terminal** on the network and destined for the device. The IP packet is **received** at a home agent for the device.

(See Dynarski, 2:38-42; *see also*, *id.*, 6:58-65 ("First, an Internet Protocol (IP) packet **from a terminal 10** on the network 12 and destined for the device 14 is relayed by router 18 onto the WAN 20 where it is received by the home agent 22.") *See also*, *id.*, 8: 9-12 ("The IP address associated with the IP link between the network access server 30B and the wireless device 14 is **forwarded** to the home agent 22 to enable the IP packet **from the remote terminal 10**. . . .").) Thus, Dynarski is clear that the home agent **receives** the IP packet. Due to the fact that the home agent 22 receives such an IP packet, it cannot assign such an IP packet, or anything included within the IP packet. Put another way, if an address is already included in an IP packet that is received by the home agent, the address is already assigned by an entity other than the home agent.

Dynarski also indicates that the "home agent then transmits an Access-Request message to the authentication server for authentication." (*See id.*, 2:54-55; *see also*, *id.*, 2:59-61 ("The Access-Request message includes a destination IP address for the wireless device **that was included in the IP packet from the terminal on the network.**"); *see also*, *id.*, 6:65 to 7:4 ("[T]he home agent then transmits an Access-

Request message to the authentication server 28 for authentication. The Access-Request message includes the destination IP address for the wireless device 14 **that was included on the IP packet from the terminal 10 on the network**).) Again, per Dynarski, the “destination IP address” is already included in the IP packet, which the home agent **receives** from the terminal 10. Accordingly, the home agent could not have “assigned” such an address.

Dynarski also indicates that the “home agent transmits a message, such as an Address Resolution Protocol (ARP) containing **the IMSI/ESN number or other information uniquely identifying the device....**” (See *id.*, 3:5-8.) Again, use of “the” indicates that the number or “other information” already exists. There simply is no indication in Dynarski, however, that the home agent “assigns” such number or information to a device.

Accordingly, claim 1 is allowable because the proposed combination of Dynarski and Wood fail to disclose or suggest the limitation of “assigning, by said headend, an address to said first device coupled to said communication network.”

3. Dynarski and West Fail to Disclose or Suggest The Communicating Limitation of Claim 1

Claim 1 is also allowable because the proposed combination of Dynarski and West fails to disclose or suggest “in response to said headend receiving an identifier of said first device from said first device, communicating, by said headend, one or both of said transferred assigned address and/or said identifier of said first device to at least one communication server coupled to said communication network,” as recited in the Appellant’s claim 1. According to the Office Action, this limitation is disclosed in

Dynarski at column 6, line 55 to column 8, line 50. (See Final Office Action, p. 3.) In making this allegation, the Office Action merely cites to this lengthy passage (nearly 2 full columns) of Dynarski. The Office Action fails to explain how the cited passage discloses or suggests the claimed communicating limitation. Accordingly, the Appellant submits that the Examiner has failed to meet his burden of showing that the references disclose or suggest all of the limitations of claim 1. See, e.g., *In re Wada and Murphy*, Appeal 2007-3733 (A proper obviousness determination requires that an Examiner make "a searching comparison of the claimed invention – **including all its limitations** – with the teaching of the prior art.")

In any event, there is nothing in the cited passage, nor elsewhere in Dynarski that discloses or suggests the limitation of "in response to said headend receiving an identifier of said first device from said first device, communicating, by said headend, one or both of said transferred assigned address and/or said identifier of said first device to at least one communication server coupled to said communication network." In this regard, Dynarski states the following:

The problem arises in how to route the IP packet from the terminal 10 (or 24) to the destination device, particularly where the home agent does not have any information as to where the device 14 is located. For example, the home agent 22 may not have a mobility binding record or other data from which an IP address is assigned to the device 14 which can be used to route the IP packet to the laptop 14. This situation may occur if the device has not been active in recent past, has moved into or out of the area, etc.

The authentication server 28, in a preferred embodiment, comprises a RADIUS server (a known device) providing accounting, authorization and authentication functions for a plurality of mobile users 14 and 16. Among other things, the

authentication server 28 maintains a table in memory that maps a destination IP address found in the IP packet from the remote terminal 10 or 24 destined for the wireless device 14 with information uniquely identifying the device 14 that is being "called" by the remote terminal, such as the IMSI/ESN number assigned to the wireless device 14. In a preferred embodiment, the authentication server 28 determines from the IP address or IMSI or ESN number a particular network to use to locate the device, such as the local area network 26 or the Signaling System 7 network 36. The authentication server 28 returns a vendor-specific attribute which informs the home agent 22 whether to use the LAN 26 or the SS7 network to find the mobile device 14.

(See Dynarski 5:19-27 and 5:45-61; see also, *id.*, Fig. 1A.) Dynarski further states the following:

The home agent then transmits an Access-Request message to the authentication server for authentication. An example of such an authentication server is a RADIUS server (a known device) providing accounting, authorization and authentication functions for a plurality of mobile users. The Access-Request message includes a destination IP address for the wireless device that was included in the IP packet from the terminal on the network.

The authentication server responsively issues an Access-Accept message to the home agent if the device is authorized to receive the IP packet, in other words, if the user operating the device has paid its bills, is a subscriber to the service, etc. The Access-Accept message includes two pieces of data: (a) information uniquely identifying the device that is being "called" by the remote terminal, such as the IMSI/ESN number of the device, and (b) information identifying a particular network to use to locate the device, such as the local area network or the Signaling System 7 network.

In the event that the local area network is specified, the home agent transmits a message, such as an Address Resolution Protocol (ARP) packet containing the IMSI/ESN number or other information uniquely identifying the device, on the designated network to a mobile node location server.

(*Id.*, 2: 54-3:9.)

Therefore, Dynarski discloses having a home agent communicate with an authenticating server to determine the location of a wireless device with which a remote terminal is trying to communicate. (See *id.*) The home agent sends an Access-Request message with the destination IP address to the authentication server and the authentication server may return, to the home agent, an Access-Accept message with unique identifying information of the wireless device and the particular network in which it may be located. (See *id.*) While Dynarski discloses that the home agent sends a message to a mobile node location server with information that uniquely identifies the wireless device, such action is not in response to the wireless device providing the uniquely identifying information to the home agent. Instead, sending a message to the mobile node location server occurs after the uniquely identifying information is provided to the home agent by the authentication server.

Thus, the Appellant submits that Dynarski fails to disclose or suggest "in response to said headend receiving an identifier of said first device from said first device, communicating, by said headend, one or both of said transferred assigned address and/or said identifier of said first device to at least one communication server coupled to said communication network," as recited in the Appellant's claim 1. West fails to overcome this deficiency of Dynarski. Accordingly, claim 1 is allowable of the proposed combination of Dynarski and West for at least the above reasons.

4. West Fails to Overcome The Admitted Deficiencies of Dynarski

The Examiner concedes, and the Appellant agrees, that Dynarski fails to disclose that the address is associated with the first device in the communication network at a time of the assigning and the transferring, by the headend, of the assigned address to the device. (See Final Office Action, p. 4.) The Examiner contends, however, that West overcomes those deficiencies in Dynarski and that, at the time the invention was made, one of ordinary skill in the art would add West to Dynarski to improve address management. *See id.*

As was discussed above, the Appellant contends that the Examiner has failed to establish that it would be obvious to combine West and Dynarski. However, even if these references were combined, the resulting combination still fails to overcome the deficiencies stated above with respect to Dynarski.

For example, West discloses methods and apparatus to make use of existing hotel wiring infrastructures. (See, e.g., West, 2:61-64.) In Figure 1, West discloses a head-end module (HEM) 124 connected to multiple in-room modules (IRM) 104 located in guest rooms 102 with a guest's telephone 106 and/or laptop 108 connected to the respective IRM 104. When a guest wishes to connect to the Internet, the HEM 124 or the IRM 104 may assign a network IP address to the guest's device or may translate the device's internal IP address if it already has one. (See *id.*, 5:50-6:4.) The network IP address may be temporarily associated with a globally unique IP address at the HEM 124. (See *id.*, 6:23-42.) When the Internet transaction is complete, the globally unique IP address is disassociated and made available for subsequent transactions from any

other hotel room and network IP address remains associated with the guest's device until the session ends. (*See id.*)

West, however, does not disclose or suggest "transferring, by said headend, said assigned address to said first device" and "in response to said headend receiving an identifier of said first device from said first device, communicating, by said headend, one or both of said transferred assigned address and/or said identifier of said first device to at least one communication server coupled to said communication network," as recited in the Appellant's claim 1. In West, assigning an IP address to a device without an internal IP address and translating the internal IP address of a device are mutually exclusive operations. Thus, based on the teachings of West, one cannot have the HEM 124 assign an IP address to a guest device and also receive the internal IP address from that same device such that one or both of the assigned IP address and the received internal IP address may be communicated to a server by the HEM 124.

Therefore, the Appellant respectfully submits that neither Dynarski nor West, alone or in combination, discloses, teaches, or suggests, the subject matter recited in claim 1, and thus, claim 1 is allowable. Consequently, the Appellant respectfully requests that the Board withdraw the rejection of claim 1 under 35 U.S.C. §103(a) over the proposed combination of Dynarski and West.

B. Independent Claims 11 and 21

Independent claims 11 and 21 are similar in relevant aspects to claim 1. Accordingly, independent claims 11 and 21 are also allowable over Dynarski and West at least for the reasons stated above with respect to claim 1. Consequently, the

Appellant respectfully requests that Board withdraw the rejection of claims 11 and 21 under 35 U.S.C. §103(a) over the proposed combination of Dynarski and West.

C. Dependent Claims 2, 11 and 22

Claims 2, 12 and 22 depend on independent claims 1, 11 and 21, respectively. Therefore, claims 2, 12 and 22 are allowable over the proposed combination of Dynarski and West at least for the reasons stated above with regard to claims, 1, 11 and 21.

In addition, the proposed combination of Dynarski and Wood does not disclose or suggest at least the limitation of "detecting, by said headend, **when said first device is initially coupled to said communication network prior to said assigning** of said address to said first device," as recited by the Appellant in claims 2, 12 and 20. Initially, as discussed above, the proposed combination of West and Dynarski fails to disclose or suggest the "assigning" as recited in the independent claims. Accordingly, since the combination does not disclose "assigning" in the manner required by claims 1, 11 and 21, it necessarily cannot disclose "detecting . . . prior to said assigning," as recited in claims 2, 11 and 22.

The Final Office Action alleges that the additional limitations of claims 2, 11 and 22 are disclosed by Dynarski at column 4, line 45 to column 5, line 3. (See Final Office Action, p. 4.) This passage of Dynarski reads as follows:

The present invention provides for an ability of the communications system of FIG. 1A to locate the laptop computer 14 and route packets from PC 10 to the laptop computer 14. In accordance with the invention, we provide a method of connecting a mobile wireless communications device (e.g., laptop 14) to an IP network such as networks 12 or 20. The wireless communications device 14 is a

subscriber to a wireless communications network 40. The method involves the step of authenticating the device 14 to determine whether the device is authorized to receive an IP packet from a terminal (e.g., 10) connected either directly or indirectly to the IP network. A preferred method of performing this step is described in detail below. If the device 14 is authenticated and authorized to receive the IP packet (i.e., is a current, paid up subscriber to the wireless network 40 service), the method continues with the step of searching with a location server for an existing IP address for routing the IP packet to the device. If the step of searching results in a negative result, the device 14 is paged via the wireless communications network 40. When the device 14 responds to the page, the device becomes connected to the IP network 20/12 via a network access server or Interworking Unit (e.g., 30A) coupling the wireless communications network 40 to the IP network 20/12. Thus connected, the device 14 may receive the IP packet and initiate communication via the IP network 20/12 with the source of the IP packet, remote terminal 10.

(Dynarski, 4:45-5:3.) The cited passage describes how the device 14 becomes connected to the network when it responds to the page. In addition, this passage indicates that once connected, the device 14 may receive the IP packet and initiation communication with the remote terminal 10. However, nothing in this passage, nor elsewhere in Dynarski discloses or suggests that the "detecting [occurs] prior to said assigning of said address to said first device."

Instead, the detecting occurs after a terminal, e.g., terminal 10, transmits an IP packet (which contains the IP address of the device 14) to the home agent 20. In particular, Dynarski states the following:

The method comprises the steps of **receiving** an Internet Protocol (IP) packet **from a terminal** on the network and destined for the device. The IP packet is **received** at a home agent for the device.

(See Dynarski, 2:38-42; *see also, id.*, 6:58-65 ("First, an Internet Protocol (IP) packet from a terminal 10 on the network 12 and destined for the device 14 is relayed by router 18 onto the WAN 20 where it is received by the home agent 22.") *See also, id.*, 8: 9-12 ("The IP address associated with the IP link between the network access server 30B and the wireless device 14 is forwarded to the home agent 22 to enable the IP packet from the remote terminal 10. . . .") Thus, the IP address is assigned to the device 14 before the device connects to the network, not after a detection as required by claims 2, 12 and 22.

Accordingly, claims 2, 12 and 22 are also allowable for at the above reasons. The Appellant reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 2, 12 and 20.

D. Rejection of Dependent Claims 3, 13 and 23

Claims 3, 13 and 23 depend respectively on claims 2, 12 and 22, which, in turn, depend on independent claims 1, 11 and 21, respectively. Therefore, claims 3, 13 and 23 are allowable over the proposed combination of Dynarski and West at least for the reasons stated above with regard to claims 1, 2, 11, 12, 21 and 22.

The Appellant reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 3, 13 and 23.

E. Rejection of Dependent Claims 4, 14 and 24

Claims 4, 14 and 24 depend on independent claims 1, 11 and 21, respectively. Therefore, claims 4, 14 and 24 are allowable over the proposed combination of Dynarski and West at least for the reasons stated above with regard to claims 1, 11 and 21.

In addition, the Appellant submits that the Examiner has not established a *prima facie* case of obviousness with regard to claims 4, 14 and 24 because he has failed to adequately explain how the limitation of "wherein said one or both of said transferred assigned address and/or said identifier of said first device is registered with said at least one communication server" is allegedly disclosed by the references. See, e.g., *In re Wada and Murphy*, Appeal 2007-3733 (A proper obviousness determination requires that an Examiner make "a searching comparison of the claimed invention – **including all its limitations** – with the teaching of the prior art.") In rejecting these claims, the Examiner cites to a lengthy passage (over 1.5 columns long) from Dynarski without providing any explanation of how the cited passage allegedly discloses or suggests the recited claim limitation. Accordingly, the Examiner has not met his burden of showing that the references disclose or suggest the all of the limitations of claims 4, 14 and 24.

The Appellant reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 4, 14 and 24.

F. Rejection of Dependent Claims 5, 15 and 25

Claims 5, 15 and 25 ultimately depend on independent claims 1, 11 and 21, respectively. Therefore, claims 5, 15 and 25 are allowable over the proposed combination of Dynarski and West at least for the reasons stated above with regard to claims 1, 11 and 21.

In addition, the Appellant submits that the Examiner has not established a *prima facie* case of obviousness with regard to claims 5, 15 and 25 because he has failed to adequately explain how the limitation of "broadcasting said one or both of said transferred assigned address and/or said identifier of said first device throughout at

least a portion of said communication network by said at least one communication server" is allegedly disclosed by the references. Once again the Examiner merely cites to a lengthy passage from Dynarski without providing any explanation of how the cited passage allegedly discloses or suggests the recited claim limitation. Accordingly, the Examiner has not met his burden of showing that the references disclose or suggest the all of the limitations of claims 5, 15 and 25.

The Appellant reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 5, 15 and 25.

G. Rejection of Dependent Claims 6, 16 and 26

Claims 6, 16 and 26 depend respectively on claims 5, 15 and 25, which in turn depend on independent claims 1, 11 and 21, respectively. Therefore, claims 6, 16 and 26 are allowable over the proposed combination of Dynarski and West at least for the reasons stated above with regard to claims 1, 5, 11, 15, 21 and 25.

In addition, the Appellants submit that the Examiner has not established a *prima facie* case of obviousness with regard to claims 6, 16 and 26 because he has failed to adequately explain how the limitation of "receiving said broadcasted one or both of said transferred assigned address and/or said identifier of said first device by a second device located in said at least a portion of said communication network" is allegedly disclosed by the references. In rejecting these claims, the Examiner merely cites to a passage from Dynarski without providing any explanation of how the cited passage allegedly discloses or suggests the recited claim limitation. Accordingly, the Examiner has not met his burden of showing that the references disclose or suggest the all of the limitations of claims 6, 16 and 26.

In any event, the Appellant submits that Dynarski simply does not disclose or suggest “receiving said broadcasted one or both of said transferred assigned address and/or said identifier of said first device by a second device located in said at least a portion of said communication network.” To the contrary, as discussed above in connection with claims 1 and 2, Dynarski discloses that the second device (e.g., terminal 10) transmits an IP packet (which contains the IP address of the device 14) to the home agent 20. Likewise, Dynarski suggests that the terminal 10 receives a broadcasted identifier of the first device, e.g., mobile device 14.

Accordingly, claims 6, 16 and 26 are allowable for at least the above reasons. The Appellant reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 6, 16 and 26.

H. Rejection of Dependent Claims 7, 17 and 27

Claims 7, 17 and 27 depend respectively on claims 6, 16 and 26, which in turn depend on claims 5, 15 and 25, which in turn independent claims 1, 11 and 21, respectively. Therefore, claims 7, 17 and 27 are allowable over the proposed combination of Dynarski and West at least for the reasons stated above with regard to claims 1, 5, 6, 11, 15, 16, 21, 25 and 26.

In addition, the Appellant submits that the Examiner has not established a *prima facie* case of obviousness with regard to claims 7, 17 and 27 because he has failed to adequately explain how the limitation of “wherein said one or both of said transferred assigned address and/or said identifier of said first device is registered with said at least one communication server” is allegedly disclosed by the references. In rejecting these claims, the Examiner cites to a lengthy passage from Dynarski without providing any

explanation of how the cited passage allegedly discloses or suggests the recited claim limitation. Accordingly, the Appellant submits that the Examiner has not met his burden of showing that the references disclose or suggest the all of the limitations of claims 7, 17 and 27.

The Appellant reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 7, 17 and 27.

I. Rejection of Dependent Claims 8, 18 and 28

Claims 8, 18 and 28 depend on independent claims 1, 11 and 21, respectively. Therefore, claims 8, 18 and 28 are allowable over the proposed combination of Dynarski and West at least for the reasons stated above with regard to claims 1, 11 and 21.

In addition, the Appellant submits that the Examiner has not established a *prima facie* case of obviousness with regard to claims 8, 18 and 28 because he has failed to adequately explain how the limitation of "wherein a second device desiring to communicate with said first device via said communication network requests said one or both of said transferred assigned address and/or said identifier of said first device from said communication server" is allegedly disclosed by the references. In rejecting these claims, the Examiner cites to a passage from Dynarski without providing any explanation of how the cited passage allegedly discloses or suggests the recited claim limitation. Accordingly, the Appellant submits that the Examiner has not met his burden of showing that the references disclose or suggest the all of the limitations of claims 8, 18 and 28.

In any event, Dynarski simply does not disclose or suggest "wherein a second device desiring to communicate with said first device via said communication network requests said one or both of said transferred assigned address and/or said identifier of said first device from said communication server." Instead, as discussed above, Dynarski discloses that the second device (e.g., terminal 10) transmits an IP packet (which contains the IP address of the device 14) to the home agent 20. Accordingly, since the terminal 10 already knows the IP address of the device 10, it would not make sense for it to "request" this information. Likewise, Dynarski does not disclose or suggest that the terminal 10 requests the identifier of the first device, e.g., mobile device 14.

Accordingly, claims 8, 18 and 28 are also allowable for at least the above reasons. The Appellant reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 8, 18 and 28.

J. Rejection of Dependent Claims 9, 19 and 29

Claims 9, 19 and 29 depend on claims 8, 18 and 28, respectively, which in turn depend on independent claims 1, 11 and 21, respectively. Therefore, claims 9, 19 and 29 are allowable over the proposed combination of Dynarski and West at least for the reasons stated above with regard to claims 1, 8, 11, 18, 21 and 28.

In addition, the Appellant submits that the Examiner has not established a *prima facie* case of obviousness with regard to claims 9, 19 and 29 because he has failed to adequately explain how the additional limitations of these claims are allegedly disclosed by the references. Once again, the Examiner merely cites to lengthy passages from Dynarski without providing any explanation of how the cited passage allegedly discloses

or suggests the recited claim limitation. As such, the Appellant submits that the Examiner has not met his burden of showing that the references disclose or suggest the all of the limitations of claims 9, 19 and 29.

In any event, Dynarski fails to disclose or suggest at least the limitation of "in response to said request, **said second device receives said one or both of said transferred assigned address and/or said identifier of said first device** from said communication server," as recited in claims 9, 19 and 29. Instead, as discussed above, Dynarski discloses that the second device (e.g., terminal 10) transmits an IP packet (**which contains the IP address** of the device 14) to the home agent 20. Accordingly, it neither requests the transferred assigned address and/or the identifier, as required by claims 8, 18, and 28, nor does it "receive" this information "in response to said request," as required by claims 9, 19 and 29.

Accordingly, claims 9, 19 and 29 are also allowable for at least the above reasons. The Appellant reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 9, 19 and 29.

K. Rejection of Dependent Claims 10, 20 and 30

Claims 10, 20 and 30 depend on independent claims 1, 11 and 21, respectively. Therefore, claims 10, 20 and 30 are allowable over the proposed combination of Dynarski and West at least for the reasons stated above with regard to claims 1, 11 and 21.

In addition, the Appellant submits that the Examiner has not established a *prima facie* case of obviousness with regard to claims 10, 20 and 30 because he has failed to

adequately explain how the limitation of "said second device requests said one or both of said transferred assigned address and/or said identifier of said first device from said communication server based on a known location of said first device" is allegedly disclosed by the references. In rejecting these claims, the Examiner cites to a lengthy passage (nearly 1.5 columns) from Dynarski without providing any explanation of how the cited passage allegedly discloses or suggests the recited claim limitation. As such, the Appellant submits that the Examiner has not met his burden of showing that the references disclose or suggest the all of the limitations of claims 10, 20 and 30.

In any event, Dynarski simply does not disclose or suggest that the "second device requests said one or both of said transferred assigned address and/or said identifier of said first device from said communication server based on a known location of said first device." To the contrary, as discussed above, Dynarski discloses that the second device (e.g., terminal 10) transmits an IP packet (**which contains the IP address** of the device 14) to the home agent 20. Accordingly, since the terminal 10 already knows the IP address of the device 10, it would not make sense for it to "request" this information. Likewise, Dynarski fails to disclose or suggest that the terminal 10 requests the identifier of the first device, e.g., mobile device 14.

Accordingly, claims 10, 20 and 30 are also allowable for at least the above reasons. The Appellant reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 10, 20 and 30.

CONCLUSION

Appellant respectfully submits that the pending claims of the present application should be in condition for allowance for at least the reasons discussed above. Accordingly, the Appellant requests that the Board withdraw all of the claim rejections and pass this case to issuance. The Commissioner is authorized to charge the fee for this Appeal Brief (\$540), and any additional fees or credit overpayment to Deposit Account 13-0017.

Respectfully submitted,

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CLAIMS APPENDIX
(37 C.F.R. § 41.37(c)(1)(viii))

This listing of claims will replace all prior versions, and listings, of claims in the application.

1. A method for setting up devices for communication, the method comprising:

in a communication network comprising a headend, wherein said headend enables access to said communication network for at least a first device,

assigning, by said headend, an address to said first device coupled to said communication network, wherein said address is associated with said first device in said communication network at a time of said assigning;

transferring, by said headend, said assigned address to said first device; and

in response to said headend receiving an identifier of said first device from said first device, communicating, by said headend, one or both of said transferred assigned address and/or said identifier of said first device to at least one communication server coupled to said communication network.

2. The method according to claim 1, comprising detecting, by said headend, when said first device is initially coupled to said communication network prior to said assigning of said address to said first device.

3. The method according to claim 2, wherein:

said assigned address of said first device is one of a static address, a dynamic address, or an embedded device address; and

said identifier of said first device is one of a digital certificate and a serial number.

4. The method according to claim 1, wherein said one or both of said transferred assigned address and/or said identifier of said first device is registered with said at least one communication server.

5. The method according to claim 1, comprising broadcasting said one or both of said transferred assigned address and/or said identifier of said first device throughout at least a portion of said communication network by said at least one communication server.

6. The method according to claim 5, comprising receiving said broadcasted one or both of said transferred assigned address and/or said identifier of said first device by a second device located in said at least a portion of said communication network.

7. The method according to claim 6, wherein said first device communicates with said second device utilizing said received broadcasted one or both of said transferred assigned address and/or said identifier of said first device.

8. The method according to claim 1, wherein a second device desiring to communicate with said first device via said communication network requests said one or both of said transferred assigned address and/or said identifier of said first device from said communication server.

9. The method according to claim 8, wherein:
in response to said request, said second device receives said one or both of said transferred assigned address and/or said identifier of said first device from said communication server; and

said second device transfers media between said second device and said first device utilizing said received one or both of said transferred assigned address and/or said identifier of said first device.

10. The method according to claim 8, wherein said second device requests said one or both of said transferred assigned address and/or said identifier of said first device from said communication server based on a known location of said first device.

11. A machine-readable storage having stored thereon, a computer program having at least one code section for setting up devices for communication, the at least one code section being executable by a machine for causing the machine to perform steps comprising:

in a communication network comprising a headend, wherein said headend enables access to said communication network for at least a first device,

assigning, by said headend, an address to said first device coupled to said communication network, wherein said address is associated with said first device in said communication network at a time of said assigning;

transferring, by said headend, said assigned address to said first device; and

in response to said headend receiving an identifier of said first device from said first device, communicating, by said headend, one or both of said transferred assigned address and/or said identifier of said first device to at least one communication server coupled to said communication network.

12. The machine-readable storage according to claim 11, wherein said at least one code section comprises code for detecting, by said headend, when said first device is initially coupled to said communication network prior to said assigning of said address to said first device.

13. The machine-readable storage according to claim 12, wherein:
said assigned address of said first device is one of a static address, a
dynamic address, or an embedded device address;
said identifier of said first device is one of a digital certificate and a serial
number.

14. The machine-readable storage according to claim 11, wherein said
one or both of said transferred assigned address and/or said identifier of said first
device is registered with said at least one communication server.

15. The machine-readable storage according to claim 11, wherein said
at least one code section comprises code for broadcasting said one or both of
said transferred assigned address and/or said identifier of said first device
throughout at least a portion of said communication network by said at least one
communication server.

16. The machine-readable storage according to claim 15, wherein said
at least one code section comprises code for receiving said broadcasted one or
both of said transferred assigned address and/or said identifier of said first device
by a second device located in said at least a portion of said communication
network.

17. The machine-readable storage according to claim 16, wherein said
first device communicates with said second device utilizing said received
broadcasted one or both of said transferred assigned address and/or said
identifier of said first device.

18. The machine-readable storage according to claim 11, wherein a
second device desiring to communicate with said first device via said
communication network requests said one or both of said transferred assigned
address and/or said identifier of said first device from said communication server.

19. The machine-readable storage according to claim 18, wherein:
in response to said request, said second device receives said one or both
of said transferred assigned address and/or said identifier of said first device from
said communication server; and
said second device transfers media between said second device and said
first device utilizing said received one or both of said transferred assigned
address and said identifier of said first device.

20. The machine-readable storage according to claim 18, wherein said
second device requests said one or both of said transferred assigned address
and/or said identifier of said first device from said communication server based
on a known location of said first device.

21. A system for setting up devices for communication, the system
comprising:

one or more circuits for use in a headend communicatively coupled to a
communication network, said one or more circuits operable to:
assign an address to a first device coupled to the communication network,
wherein said address is associated with said first device in said communication
network at a time of said assigning;

transfer said assigned address to said first device; and
in response to receiving an identifier of said first device from said first
device, communicate one or both of said transferred assigned address and/or
said identifier of said first device to at least one communication server coupled to
the said communication network.

22. The system according to claim 21, wherein said one or more
circuits are operable to detect when said first device is initially coupled to said
communication network prior to said assigning of said address to said first
device.

23. The system according to claim 22, wherein:

 said assigned address of said first device is one of a static address, a dynamic address, or an embedded device address; and

 said identifier of said first device is one of a digital certificate and a serial number.

24. The system according to claim 21, wherein said communication server registers said one or both of said transferred assigned address and/or said identifier of said first device.

25. The system according to claim 21, wherein said communication server broadcasts said one or both of said transferred assigned address and/or said identifier of said first device throughout at least a portion of said communication network.

26. The system according to claim 25, wherein a second device located in said at least a portion of the communication network receives said broadcasted one or both of said transferred assigned address and/or said identifier of said first device.

27. The system according to claim 26, wherein said second device communicates with said first device utilizing said received broadcasted one or both of said transferred assigned address and/or said identifier of said first device.

28. The system according to claim 21, wherein a second device requests said one or both of said transferred assigned address and/or said identifier of said first device from said communication server whenever said second device desires to communicate with said first device via said communication network.

29. The system according to claim 28, wherein, in response to said request, said second device:

receives said at least one of said transferred assigned address and said identifier of said first device from said communication server; and

transfers media between said second device and said first device utilizing said received one or both of said transferred assigned address and/or said identifier of said first device.

30. The system according to claim 28, wherein said second device requests said one or both of said transferred assigned address and/or said identifier of said first device from said communication server based on a known location of said first device.

EVIDENCE APPENDIX
(37 C.F.R. § 41.37(c)(1)(ix))

- U.S. Patent 6,272,129 (Dynarski), entered into the record by the Examiner in the May 12, 2008 Office Action.
- U.S. Patent 6,934,754 (West) entered into the record by the Examiner in the May 6, 2009 Office Action.

RELATED PROCEEDINGS APPENDIX
(37 C.F.R. § 41.37(c)(1)(x))

The Appellant is unaware of any related appeals or interferences.